UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
QIN, YIXING

ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/010,303	DAVIS ET AL.
	Examiner	Art Unit	
	Yixing Qin	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 February 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-41</u> is/are pending in the application.

   4a) Of the above claim(s) <u>4-27</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-3 and 28-41</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>13 November 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 4-27 withdrawn from further consideration pursuant to 37 CFR 1.142(b)

as being drawn to a nonelected invention, there being no allowable generic or linking

claim. Election was made **without** traverse in the reply filed on 2/27/07.

Response to Amendment

In response to applicant's amendment received 2/28/07, all requested changes

have been entered.

Response to Arguments

Applicant's arguments filed 2/28/07 have been fully considered but they are not

persuasive. The argument is that the Okimoto reference does not show that the data

transferred can be any other format other than the PDL or, generally, a page descriptor

format. However, column 11, lines 42-43 and column 14, lines 16-48 discloses that a

print mail is created by combining print data with various other data such as envelope

data 50a. This print mail is interpreted to be the native format. This mail is still created

in the local computer in response to a request for printing. This request is associated

with the print mail since the print mail is created according to the print data that the

request is referring to.

The arguments directed towards the claims other than claims 1 and 28 and their

dependents are not considered at this time because those claims have been withdrawn

from consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

I.   Claims 1-3, 28-31, 34-39 and 41 are rejected under 35 U.S.C 102(e) as being

anticipated by Okimoto et al (U.S. Patent No. 6,160,631)

Regarding claim 1, Okimoto discloses a system for remote printing, comprising:

a local computer having at least one document stored thereon, said document

being associated with at least one native data format, said format being other than a

page descriptor format, said local computer adapted for accepting a print request

associated with said document; (column 11, lines 42-43 – "print" or "mail" are two

printing request options – column 14, lines 16-48 discloses that a print mail is created

by combining print data with various other data such as envelope data 50a. This print

mail is interpreted to be the native format.)

a remote printer; (Fig. 1 – printers 14, 16, 18)

and a remote computer, associated with said remote printer and adapted for receiving said print request and, in response to said receiving of said print request, automatically causing said at least one document to be printed on said remote printer; (Fig. 1 – computers 10, 12, column 15, lines 3-13 discloses the transferring of print mail over the Internet)

wherein said at least one native data format of said document is maintained in said document printed by said remote computer on said remote printer. (as disclosed in column 5, lines 34-36, the print data is printed at the remote computer "B". From column 11, lines 42-43 and column 14, lines 16-48, however, discloses that a print mail is created by combining print data with various other data such as envelope data 50a. Since this print mail is the native format, the remote computer's reception of this print mail indicates that this format is kept.)

Regarding claim 2, Okimoto discloses further comprising a relay computer, configured and adapted to:

receive said print request from said local computer; and

send said print request to said remote computer. (Fig. 1 of Okimoto shows two mail server, whose tasks are to relay the mail messages from one computer to another. Column 14, lines 28-35 discloses that an user inputs print settings and a mail header is created according to these settings to be sent to a remote computer – one

could also interpret the mail sent to the remote computer as a print request since the header contains information requesting the printing of print data attached to the mail)

Regarding claim 3, Okimoto discloses wherein said remote computer:

periodically polls said relay computer to determine whether one or more of said print requests intended for said remote printer are waiting to be sent; and

if said one or more print requests are waiting to be sent, retrieving said print requests, and printing the documents associated with said print request on said remote printer. (Okimoto discloses in Figs. 8 and 10 and column 15, lines 21-45 the idea of checking for new mail from a POP server 38 in the mail server and that is repeated at a certain interval (column 15, lines 29-31). The new mail is then sent to the mail reception utility 31b.

Regarding claims 28, 36, these claim has been addressed in claim 1 above. In regards to the second limitation of receiving data in a format other than the native format, Okimoto discloses in Fig. 17 the format of a print mail. One can see there is envelope and header data that is also sent to the remote printer. This data is in a format that is not the native PDL format.

Regarding claims 29, 37, Okimoto disclose wherein said remote printer is directly connected to said remote computer." (Fig. 1 shows printer 6 directly connected to PC 4)

Regarding claims 30, 38, Okimoto discloses "The system of claim 28, wherein said remote printer is coupled to said remote computer through a network". (Fig. 1 shows printers 14,16,18 through a network to PC 10, 12)

Regarding claim 31, 39, 41, Okimoto discloses "The system of claim 28, further comprising:

a relay computer coupled to said local computer and said remote computer to receive said at least one document in said first format from said local computer and provide said at least one document in said native data format to said remote computer." (Fig. 1 of Okimoto shows two mail server, whose tasks are to relay the mail messages from one computer to another. Column 14, lines 28-35 discloses that an user inputs print settings and a mail header is created according to these settings to be sent to a remote computer – one could also interpret the mail sent to the remote computer as a print request since the header contains information requesting the printing of print data attached to the mail)

Regarding claim 35, this claim has been addressed in claim 14 above. (one can read the print mail transmission utility 31a and the print mail reception utility 31b as the application for generating a document and the application for printing the document – see Fig. 3)

II.   Claims 32, 33 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto (U.S. Patent No. 6,160,631) and in view of Greenstein (U.S. Patent No. 6,266,692).

Regarding claims 32, 33 and 40, Okimoto discloses a method for remotely printing a document.

Okimoto does not explicitly disclose "wherein the user of said local computer is authenticated prior to said at least one document being printed on said remote printer".

However, Greenstein, discloses in the abstract, lines 1-6 that an email header contains a password so that a recipient knows the email is not spam.

Okimoto and Greenstein are combinable because they are in the art of relaying information. Greenstein is cited just to show that emails are known to have password/authentication information embedded into it. Although they are detecting for

spam, the detection for an user ID would be just as obvious and is well-known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have created a document message with authentication information.

The motivation would have been to enable a printer or a server to make sure that a proper document is to be printed.

Therefore, it would have been obvious to combine Okimoto and Greenstein to obtain the invention as specified in the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YQ

KING Y. POON
PRIMARY EXAMINER